

REMARKS

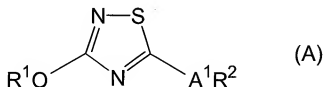
Claims 12-27 are currently pending in the present application.

In the Office Action, the Examiner has indicated that the foreign patent document DE 3030661 A1 cited in the Information Disclosure Statement (IDS), filed April 22, 2005, has not been considered, because it is not in the English language. DE 3030661 A1 was cited in the International Search Report (ISR) and the International Preliminary Examination Report (IPER), both of which were submitted to the USPTO in the English language. Applicants respectfully submit that DE 3030661 A1 has been properly submitted in compliance with 37 C.F.R. § 1.98 (a)(3)(i). Therefore, consideration of DE 3030661 A1 is respectfully requested.

For clarity, claims 1-11 have been canceled and new claims 12-27 have been added, without prejudice. New claims 12-21 correspond to claims 1-7 and 9-11, respectively. New claims 22-26 have no corresponding cancelled claims, but are supported by the disclosure in the originally filed application. For example, support for claims 22-24 is found from page 14, line 17 to page 16, line 12, of the application; support for claims 25-27 is found at page 14, lines 17 to 19, and at page 16, line 13. It is respectfully submitted that the amendments made herein are supported by the Specification and the original claims and introduce no new subject matter. Additionally, no additional claim fees are necessitated. Moreover, it is believed that the new claims overcome the Examiner's rejections as discussed below. Entry of the amendments made herein is proper and respectfully requested.

In the Office Action, the Examiner has provisionally rejected claims 1-11 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of a co-pending Application No. 10/530,136 ('136). The Examiner alleges that many of the 1,2,4-thiadizole compounds in the present claims and the '136 application overlap and some of the compounds are identical. Applicants respectfully traverse for the following reasons.

Compounds in the present claims do not overlap with those claimed in the '136 application. The compound in the present claims is a 1,2,4-thiadiazole compound represented by the formula (A):

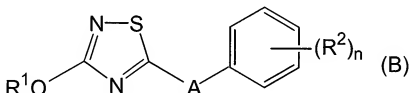


The 5-position of the compound of formula (A) is:

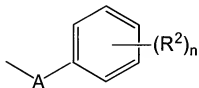


wherein A¹ represents a single bond, C₁-C₂ alkylene or C₂-C₃ alkylidene, and R² represents optionally substituted C₃-C₈ cycloalkyl, C₅-C₈ cycloalkenyl or C₇-C₁₁ bicycloalkyl. Clearly, the 5-position of the 1,2,4-thiadiazole compound in the present claims **does not contain a benzene ring**.

On the other hand, the compound claimed in the '136 application is a 1,2,4-thiadiazole compound represented by the formula (B):



The 5-position of the compound of formula (B) is:



which **always contains a benzene ring**.

The 1,2,4-thiadiazole compound in the present claims is not anticipated by the compound claimed in the '136 application, because the compounds of formulas (A) and (B) are different at

the 5-position and do not overlap. The 1,2,4-thiadiazole compound in the present claims is also not obvious over the compound claimed in the '136 application, because it would not have been obvious to replace a group containing a benzene ring with a C₃-C₈ cycloalkyl, C₅-C₈ cycloalkenyl or C₇-C₁₁ bicycloalkyl at the 5-position of a 1,2,4-thiadiazole compound. The only reason the Examiner has given for obviousness is that the claims overlap, but that is incorrect as pointed out above. Accordingly, reconsideration and withdrawal of the provisional obvious-type double patenting rejection are respectfully requested.

In the Office Action, the Examiner rejects claims 6-8 under 35 U.S.C. §112, first paragraph, for lack of enablement. Claims 6-7 are canceled and substituted with new claims 17-18, respectively. Claim 8 is canceled without a substituting new claim. The comments from the Examiner are not totally understood. Reading them as a whole, Applicants believe the Examiner meant to say that the application is enabling for controlling arthropods such as insects and acarines, including Hemiptera, Lepidoptera, Diptera, Coleoptera, Thysanoptera, Hymenoptera, Dictyoptera, Orthoptera, Anoplura, Isoptera, and Acarina, but is not reasonably enabling for controlling ALL arthropods. Applicants respectfully traverse the Examiner's rejection for the following reasons.

The written description requirement does not require identical descriptions of claimed compositions, but only requires sufficient detail to allow one of ordinary skill in the relevant art to practice the invention without undue experimentation. "The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine." In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988).

As the Examiner correctly points out, the state of the pesticide art is well developed. The present application states the ability of 1,2,4-thiadiazole compounds to control arthropod pests including Hemiptera, Lepidoptera, Diptera, Coleoptera, Thysanoptera, Hymenoptera, Dictyoptera, Orthoptera, Anoplura, Isoptera, and Acarina. The present application further provides working example to show the ability of 1,2,4-thiadiazole compounds to control cotton aphid, which belongs to the class of Hemiptera.

Applicants respectfully submit that one of ordinary skill in the art, upon reading the present application, would be capable of and enabled to design and carry out any necessary

protocols or experiments to use a compound of the present invention for controlling any arthropods. Such protocols or experiments for pesticide control are routine and known in the well developed pesticide art. As the court in Wands observed, a considerable amount of routine experimentation is permissible and such experimentation is not undue. Therefore, Applicants respectfully submit that claims 17-18 are enabled. Reconsideration and withdrawal of the lack of enablement rejection are respectfully requested.

New claims 22-24 relate to controlling insect pests and new claims 25-27 relate to controlling acarine pests. As the Examiner suggests in the Office Action, as well as the above discussion relating to claims 17-18, the present invention is enabling for controlling insects and acarine pests. Therefore, Applicants respectfully submit that claims 22-27 are enabled and allowable.

In the Office Action, the Examiner also rejects claim 8 under 35 U.S.C 101 for recitation of a use, without setting forth any steps involved in the process, resulting in an improper definition of a process. Claim 8 is canceled without a substituting new claim. The rejection becomes moot in view of the cancellation. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Besides addressing rejections detailed in the outstanding Office Action, new claims 12-27 include additional changes for clarity only without changing the meaning or scope of the claims. For example, new claims contain the phrase “C₃-C₇” instead of “C3-C7” used in the original claims, and new claims contain the phrase “is optionally substituted” instead of “may be substituted” used in the original claims. It is respectfully submitted that all amendments made herein are supported by the Specification and the original claims and introduce no new subject matter.

Applicants respectfully submit that the pending claims 12-27 are definite and comply with the written description requirement. Accordingly, reconsideration, withdrawal of all rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,
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(Date)

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